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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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08/31/2001

JiNan Glasgow

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TRIANGLE PATENTS, P.L.L.C.

P.O. BOX 28539

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EXAMINER

LY, ANH

ART UNIT

PAPER NUMBER

2162

MAIL DATE

DELIVERY MODE

06/06/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/943,799

Applicant(s)

GLASGOW, JINAN

Examiner

Anh Ly

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/07/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Office Action is response to Applicant's AMENDMENT filed on 11/07/2007.
2. Claims 18-19 have been cancelled.
3. Claims 1-17 are pending in this Application.

### ***Response to Arguments***

4. Applicant's arguments, see Remarks, filed 11/07/2007, with respect to the rejection(s) of claim(s) 1-17 under "wherein the diagrammatic representation comprises ... includes the textual component content" have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Patent Number: US 6,055,544 issued to DeRose et al.

The applied reference, TRAN (Pub. No.: US 2006/0190807 A1) teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, section 0052) and including at the step 312, the system diagramming the elements of a claim (sections 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (section 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2006/0190807 A1 of TRAN in view of Patent No.: US 6,055,544 issued to DeRose et al. (hereinafter DeRose).

With respect to claim 1, TRAN teaches a system for drafting a patent application and assessing technological information on at least one computer (fig. 1, a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: sections 0006, 0010 and 0132-0133), the system comprising:

at least one input device connected to the at least one computer for inputting information from at least one user (inputting from one of client computers: fig. 1, items 104 and 106, sections 0035);

at least one processing means for generating a diagrammatic representation of an invention (using graphical user interface and software for assisting the user in generating a patent application: sections 0042-0043 and fig. 2A and 2C), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the invention based upon the information inputted by the at least one user (fig. 3B a claim tree, sections 0068), and for automatically generating a

document for filing as a patent application (automatically generating a patent application: fig. 2's section 0042), including specification and claims, based upon the information inputted by the at least one user and additional text-based detailed information that is organized consistent with the diagram (technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, sections 0008, 0016, 0046 and 0101-0103); wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto, wherein the diagrammatic representation of the components and subcomponents together provides an indication of what may be claimed in a patent application (independent claims and dependent claims: in fig. 3B claim tree and sections 0053-0054); and

at least one output device connected to the at least one computer for outputting the automatically generated diagrammatic representation of an invention (the claim tree is displayed on the desktop screen, output device: section 0127 and fig. 3B).

TRAN teaches a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, section 0052) and including at the step 312, the system diagramming the elements of a claim (sections 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the

hierarchy of elements (section 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content associated with each component such that for each component, the graphical component structure includes the textual component content.

However, DeRose teaches graphical components of a book or a document such as front, body, title, chapter, section and sub-section. This is the same as the graphical component of a patent including drawings, claims, abstract, summary and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see fig. 3, col. 8, lines 12-40 and col. 18, lines 57-67 and col. 19, lines 1-3).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings of DeRose. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a book, a document or a patent's components as disclosed (DeRose's col. 18, lines 57-67), into the system of TRAN for the purpose of presenting graphical component structure of a document, thereby, enabling a user to select or view or scroll through previous and subsequent portions of the electronic document (DeRose's col. 4, lines 12-40).

With respect to claim 2, TRAN teaches wherein the diagram is modifiable by the at least one user and the diagram hierarchical component categorization and

related text-based detailed information is automatically updated based upon the user modifications (the text of a patent application is enabling to update or edit: section 0044 and claim tree is also able to move or to modify (drag/drop claims): sections 0068).

With respect to claim 3, TRAN teaches wherein the at least one key component includes a multiplicity of components (such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: sections 0068 or a patent application has background, summary, description, drawings and claims components: sections 0008, 0016 and 0044-0045).

With respect to claim 4, TRAN teaches wherein the at least one subcomponent further includes at least one sub-subcomponent (independent and dependent claims: claim tree: sections 0068 and 0053-0054).

With respect to claim 5, TRAN teaches wherein the relational connection between components establishes the claims structure of the patent application (relationship between component in the data structure: section 0101 and fig. 4).

With respect to claim 6, TRAN teaches wherein the text-based information and the diagram components are automatically linked (the links of the text-based: description: section 0044).

Claim 11 is essentially the same as claim 16 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 1 hereinabove.

With respect to claim 12, TRAN teaches further including the step of: at least one user entering diagram verbiage by drafting the text-based detailed description or

verbiage of the specification section of the application for each component of the diagram (a process performed by the software for assisting the user in generating a patent application: figs. 2's and 3B).

With respect to claim 13, TRAN teaches further including the step of: at least one user inputting additional components selected from the group consisting of key components, subcomponents, and sub-subcomponents (a patent application has background, summary, description, drawings and claims components or such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: sections 0068; also see sections 0008 and 0016).

With respect to claim 14, TRAN teaches further including the steps of: modifying any previously inputted components within the diagram; and the system automatically updating the diagram and relational information to those modified components (the text of a patent application is enabling to update or edit: section 0044 and claim tree is also able to move or to modify (drag/drop claims): sections 0068).

With respect to claim 15, TRAN teaches further including the step of: automatically generating a patent application based upon the inputted information and the hierarchical diagram, including specification and claims (such as one independent claim has one or more dependent claims as shown in the fig. 3B: claim tree: sections 0068 or a patent application has background, summary, description, drawings and claims components: sections 0008, 0016 and 0044-0045).

With respect to claim 16, TRAN teaches a system for mapping technology using at least one computing device (fig. 1, a system for user(s) such as IP specialist or



attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application: sections 0006, 0010 and 0132-0133), comprising:

at least one input device connected to the at least one computing device for inputting information from at least one user (inputting from one of client computers: fig. 1, items 104 and 106, sections 0035);

at least one processing means for automatically generating a diagrammatic representation of a technology (using graphical user interface and software for assisting the user in generating a patent application: sections 0042-0043 and fig. 2A and 2C), wherein the diagrammatic representation includes a hierarchical component categorization of the technical components of the technology based upon the information inputted by the at least one user, wherein the hierarchical component categorization includes at least one key component and at least one subcomponent related thereto (fig. 3B a claim tree, sections 0068; automatically generating a patent application: fig. 2's section 0042; technical component such as background, description, drawings and claims: abstract, figs. 2C, 3A and 4-5, sections 0008, 0016, 0044-0046 and 0101-0103; and independent claims and dependent claims: in fig. 3B claim tree and sections 0053-0054); and

at least one output device connected to the at least one computing device for outputting the automatically generated diagrammatic representation of a technology (the claim tree is displayed on the desktop screen, output device: section 0127 and fig. 3B).

TRAN teaches a system for user(s) such as IP specialist or attorney in drafting or writing patent applications or patent claims as well as technical information as legal matters for a patent application, generating an patent application including some technical components such background, invention summary, drawings, description, abstract and claims and displaying the claim tree to user. Also, TRAN teaches displaying a flowchart of steps of claim drafting with user input (fig. 3A, section 0052) and including at the step 312, the system diagramming the elements of a claim (sections 0068-0079) and fig. 3B illustrating the diagrammed claim, showing the hierarchy of elements (section 0080), analogous to the claimed components and subcomponents, wherein the highest level node in fig. 3B is the claimed at least one key component. TRAN does not explicitly teach wherein the diagrammatic representation comprises graphical component structure and textual component content associated with each component such that for each component, the graphical component structure includes the textual component content.

However, DeRose teaches graphical components of a book or a document such as front, body, title, chapter, section and sub-section. This is the same as the graphical component of a patent including drawings, claims, abstract, summary and detail specification and is illustrated and displayed under a hierarchical tree with graphical component structure (see fig. 3, col. 8, lines 12-40 and col. 18, lines 57-67 and col. 19, lines 1-3).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN with the teachings

of DeRose. One having ordinary skill in the art would have found it motivated to utilize the use of graphical representation of a book, a document or a patent's components as disclosed (DeRose's col. 18, lines 57-67), into the system of TRAN for the purpose of presenting graphical component structure of a document, thereby, enabling a user to select or view or scroll through previous and subsequent portions of the electronic document (DeRose's col. 4, lines 12-40).

Claim 17 is essentially the same as claim 16 except that it is directed to a method rather than a system, and is rejected for the same reason as applied to the claim 16 hereinabove.

6. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No.: US 2006/0190807 A1 of TRAN in view of Patent No.: US 6,055,544 issued to DeRose et al. (hereinafter DeRose) and further in view of Pub. No. US 2002/0161733 A1 of Grainger.

With respect to claim 7-10, TRAN in view of DeRose discloses a system as discussed in claim 1.

TRAN and DeRose disclose substantially the invention as claimed.

TRAN and DeRose do not teach wherein the link(s) are hyperlinks, wherein the document and diagram are capable of being output into another software program, wherein the document and diagram are exportable in HTML format and wherein the document and diagram are exportable in XML format.

However, Grainger teaches HTML link (sections 0038 and 0052), web browser (sections 0137 and 0159), HTML document (sections 0042 and 0052) and XML document (section 0038).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of TRAN in view of DeRose with the teachings of Grainger. One having ordinary skill in the art would have found it motivated to utilize the use of facilitating the preparation of intellectual property (IP) documents, generating a document for filing as a patent application including patent's assessment, in the same conventional manner as described by Grainger (sections 0004 and 0023). thereby, securing and managing IP rights and assets (Grainger's section 0002).

***Conclusion***


7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

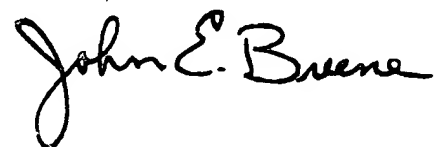
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

**Contact Information**

8 Any inquiry concerning this communication or earlier communications from the examiner should direct to ANH LY, whose telephone number is (571) 272-4039 or via e-mail: ANH.LY@USPTO.GOV (written authorization being given by Applicant(s) - MPEP 502.03 [R-2]) or fax to (571) 273-4039 (unofficial fax number direct to examiner's office). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene, can be reached on (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: Central Fax Center: (571) 273-8300

ANH LY   
DEC 30<sup>th</sup>, 2007



JOHN BREENE  
SUPERVISORY PATENT EXAMINER  
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